

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:)	
)	
HENRY, Steven, G.)	Examiner: Greene, S.L.
)	
Serial No. 09/998,795)	Group Art Unit: 2173
)	
Filing Date: December 3, 2001)	Conf. No.: 7073
)	
For: METHOD AND APPARATUS FOR)	Atty. Dkt.: 10016443-1
DISPLAYING NETWORK DATA)	

APPELLANT'S REPLY BRIEF

To: The Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer, paper number (unspecified), dated December 14, 2006.

RESPONSE TO EXAMINER'S ANSWER

In section 21 of the Examiner's Answer, the examiner responds to the arguments made by Appellant in the Appeal Brief by stating that the "Appellant only relies on the sworn statement as evidence" and that "Appellant have (sic) not provided factual evidence to show conception." The examiner then concludes that the "declaration is insufficient and not persuasive." These statements and conclusions are incorrect.

First, the sworn statements contained in the Rule 131 declaration are factual evidence and are sufficient to show conception. The Rule 131 declaration states that "on September 6, 2001,

the law firm of Dahl & Osterloth, L.L.P. sent to me, via e-mail, a draft patent application for the subject invention.” This is a statement of fact, not opinion, and confirms several salient facts:

- 1). That a **draft** of the patent application was prepared by the inventor’s attorney;
- 2). that the draft was sent to the inventor via e-mail; and
- 3). that the e-mail was sent to the inventor on September 6, 2001.

Second, in finding the declaration “not persuasive,” the examiner ignores the well-established legal rule that conception is established by the fact that a draft of the patent application was sent to the inventor. See, for example, MPEP 2138.06 and *Burroughs Wellcome Co., v Barr Laboratories, Inc.*, 40 F.3d 1223 (Fed. Cir. 1994), which were discussed in the Appeal Brief. Significantly, the examiner does not attempt to distinguish the facts of the present situation from the well-established law in this area. Rather, the examiner simply re-states the unsupported conclusion that the declaration is “not sufficient.”

Appellant has clearly and factually established that a draft of the patent application was sent to the inventor on September 6, 2001. Under the law, which is not disputed by the examiner, such an activity establishes conception. That is, conception of the invention occurred at least as early as September 6, 2001. No additional evidence is required to establish conception, as articulated in MPEP 2138.06 and *Burroughs Wellcome, supra*.

The Board of Patent Appeals and Interferences has considered this type of situation before, and its rationale cannot be improved upon. In the case of *Ex Parte Gilbert P. Hyatt* (1996 WL 1761844 (Bd. Pat. App. & Interf.)) the Board stated:

“In the situation where **evidence** is required to overcome a rejection and an applicant does not submit any evidence, than any statements made by applicant can be treated as simple arguments. That situation is not presented here because appellant has submitted a declaration containing statements of **fact**. Such statements of **fact** cannot be dismissed as being self serving. If a declarant is stating an opinion about something, then the personal interest the declarant has in the matter can be a factor in assessing the persuasive weight to be given to the

opinion. If a declarant is stating **facts**, however, these facts **must** be accepted as true unless the examiner has a reasonable basis for questioning the accuracy of the statements. . . Thus, **the examiner cannot ignore these facts submitted by appellant simply because they are in the appellant's self interest.**" (citation omitted, emphasis added).

Here, the examiner has not even taken the position that the factual statements contained in the declaration are made in the Appellant's self interest, thus can be ignored. Instead, the examiner merely concludes, without any rationale, that the declaration is "not sufficient" and that the Appellant has not submitted any "factual evidence."

The record is to the contrary. The declaration contains numerous statements of facts, which are clearly evidence under the holding in *Ex Parte Gilbert P. Hyatt, supra*. Moreover, because the facts in the declaration establish that a draft of the patent application was completed and forwarded to the inventor on September 6, 2001, the date of conception of the invention is established to be at least as early as that date. See, for example, MPEP 2138.06 and *Burroughs Wellcome, supra*. The examiner has not challenged the rule of law in this area, nor has the examiner attempted to distinguish this case as somehow falling outside the rule. The evidentiary facts submitted by the Appellant have not been challenged, nor has the examiner provided any basis, much less a reasonable basis, for questioning the accuracy of the factual statements set forth in the Rule 131 declaration. Therefore, the factual assertions provided in the Rule 132 declaration must be accepted as true, and conception of the invention must be regarded as having been established at least as early as September 6, 2001.

In summation, then, Appellant has established that conception of the invention occurred at least as early as September 6, 2001, which is earlier than the October 9, 2001, filing date of the Rudd patent. Appellant has also established that diligent constructive reduction to practice occurred between the filing date of the Rudd patent and the filing date of the present application. Consequently, the Rudd patent is not available as a reference and cannot support the examiner's

anticipation and obviousness rejections. Therefore, Appellant respectfully requests the Board to reverse the rejections of claims 1-11 and 13-31.

Respectfully submitted,

By: 

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